

REMARKS

The Examiner provides a number of rejections and we list them here in the order in which they are addressed:

- I. Claims 1-9 are rejected under 35 USC § 112 ¶ 2 as allegedly being indefinite.
- II. The specification is objected to as having errors. Modifications are requested.

I. Claims 1-9 Are Definite

A. The Examiner's Action Is Incomplete

The Applicants note that the Examiner has rejected Claims 1-9 under 35 USC § 112 ¶ 2 as being indefinite but only provides reasons for Claims 1-5. The present Office Action does not comply with statutory regulations stating that "The Examiner's action will be complete as to all matters ..." (37 CFR 1.104) and that "In every office action, [for] each pending claim ... its treatment or status given". (MPEP 707.07(i)). In the present Office Action, the Examiner does not clearly and distinctly explain the rejection of Claims 6-9. The Applicants, therefore, do not have a present opportunity to respond to the Examiner's rejection of Claims 6-9. Consequently, any immediately subsequent Final Office Action also rejecting Claim 6-9 would be inappropriate.

Despite this oversight, the Applicants assume that the Examiner might have intended to reject Claims 6-9 under the same rationale as explained for Claims 1-5. The Applicants, therefore, herein provide a response directed to that potential rejection.

B. The Preambles Of Claims 1 and 6 Have No Patentable Weight

The Examiner rejects Claim 1 because "There is no recitation of a purpose of the method in the preamble of the claim, therefore the metes and bounds of the method are indefinite." (*Office Action*, pg 3) and because " ... it [Claim 1] does not recite a positive process step referring to the preamble of the claim. Without such a step, it is unclear what the method is actually drawn to because there is no end to the method, thus the metes and bounds of the claim are indefinite.". (*Office Action*, pg 4).

The Examiner is reminded that a claim preamble has patentable weight only if "necessary to give life, meaning, and vitality" to the claims. *Pitney Bowes v. Hewlett-*

Packard, 182 F.3d 1298, 1305 (Fed. Cir. 1999); and MPEP 2111.02. The Applicants provide the Federal Circuit opinion regarding preambles and their importance in claim interpretations:

Language in a claim preamble, however, acts as a claim limitation only when such language serves to "give meaning to a claim and properly define the invention," not when the preamble merely states a purpose or intended use of the invention. *Apple Computer, Inc. v. Articulate Systems, Inc.*, 234 F.3d 14; 2000 U.S. App. LEXIS 31213; 57 U.S.P.Q.2D (BNA) 1057 (citing *In re Paulsen*, 30 F.3d 1475, 1479, 31 U.S.P.Q.2D (BNA) 1671, 1673 (Fed. Cir. 1994) (quoting *DeGeorge v. Bernier*, 768 F.2d 1318, 1322 n.3, 226 U.S.P.Q. (BNA) 758, 766 n.3 (Fed. Cir. 1985)).

Further, the Examiner attempts to require essential structural requirements for a preamble (*i.e.*, either referenced by the body of the claim or establishing the metes and bounds of a claim). The Applicants know of no such preamble requirements in patent law and the Examiner fails to cite any authority for these requirements.

The MPEP discussion regarding preambles is also limited as to how, and when, the words of a preamble will be construed to limit a claim. Contrary to the Examiner's analysis, the MPEP provides no instruction regarding preamble construction or content requirements (other than improvement claims which are not currently pending) Applicants believe that the rejection is unjustified in that the definiteness of a claim depends on the entire claim - not just the preamble. When the claims are examined in their entirety, one skilled in the art clearly would understand the various steps in the method. This is sufficient under law.

Nonetheless, without acquiescing to the Examiner or waiving the above-indicated arguments, but to further the prosecution and expressly reserving the right to prosecute the unamended (or similar) claims in the future, the preambles of Claims 1 and 6 have been amended to recite "... creating a tRNA/coumarin marker conjugate..." and "... protein synthesis", respectively.

C. Claims 2-5 and 7-9 Are Proper Dependent Claims

1. The Examiner Improperly Rejects The Dependent Claims

The Examiner states that "... claims 2-5 are indefinite for not reciting a purpose in the preamble of the method." (*Office Action*, pg 3) and specifically, "... claim 3 ... cannot properly depend from claim 1 as it does not further limit the independent claim. The Applicants disagree and point out that a rejection under this rationale is improper:

Claims which are in improper dependent form for failing to further limit the subject matter of a previous claim should be objected to under 37 CFR 1.75(c) by using form paragraph 7.36. *MPEP* 608.01(n) II.

The Applicants argue that the Examiner's rejection of Claim 3 is improper because dependent claims that do not further limit independent claims can only be OBJECTED TO, not rejected.

2. Dependent Claims May Have Additional Purposes

The Examiner concludes that Claim 1 cannot be drawn to a "method of creating" without contradicting the "detecting" purpose of dependent Claim 3. The Applicants disagree and argue that "detecting" is an allowable step in a "method of creating" because of the use of the transition term "comprising" in Claim 1, and the combination of these method steps is clearly and distinctly described in the Applicants' specification.

The Examiner has provided no authority for the premise that a dependent claim cannot have an additional purpose. As such, the Examiner's statement is considered conclusory and without merit. The fact that Claim 1 utilizes an open transition word and comprises the preamble purpose is sufficient to form a proper independent claim. Thereafter, the Applicant is free to draft dependent claims that add additional features to the independent claim.

D. The Use Of "Marker" Is Clear

The Examiner rejects Claims 2 and 3 as being allegedly indefinite because "... the limitation "said marker" in steps (c) and (d) of the claims ... [has] insufficient antecedent basis ..." *Office Action*, pg. 4. The Applicants disagree. A reading of the specification makes clear that the purpose of the "tRNA/marker conjugate" is to introduce the marker into nascent proteins (e.g. "if a BODIPY marker which consists of a BODIPY conjugated to methionine is incorporated by a misaminoacylated initiator tRNA . . .") (p. 43, lines 17-19). The Applicants believe, therefore, that the claims are written with sufficient clarity that one having skill in the art would realize that "said marker" refers to the marker of the conjugate. Nonetheless, without acquiescing to the Examiner or waiving the above-indicated arguments, but to further the prosecution and expressly reserving the right to prosecute the unamended (or similar) claims in the future, Claim 2 has been amended. Since Claim 3 depends on Claim 2, the change also clarifies Claim 3.

II. The Specification Is Adequate

A. The Meaning of "BODIPY" Is Clear

The Examiner states that "The specification repeatedly refers to "BODIPY", yet there is no definition of what the acronym stands for.". *Office Action pg 2.* This is not correct.

The Applicants point out to the Examiner the following paragraph:

One group of fluorophores with members possessing several favorable properties ... is the group derived from dipyrrometheneboron difluoride derivatives (BODIPY) ...
Applicants' Specification, pg. 33 ln 7-10.

Thus, the specification adequately defines the term. Applicants wish to also point out Figure 19 and Table 2.

B. The Open Parenthesis Are Simple Typographical Errors

The Examiner cites the sentences appearing at page 94 ln 3-5, page 94 ln 13-15, page 95 ln 17-20 and page 95 ln 27 - page 96 ln 1 as "... making it unclear what is actually the main part of the specification". *Office Action, pg. 3.* The Examiner concludes that the repeated appearances of lone open parentheses prior to the letter "l" results in "... everything after the first parenthesis ... [being] parenthetical in the entire specification ..." *Office Action, pg 3.* The Applicants disagree because the Examiner should realize from the context of these sentences that the lone open parenthesis are actually simple typographical errors for the letter "μ". Applicants point out, for example, the text of page 110 of the specification:

"Ethanol (2.5 volumes) was added to the aqueous phase and the tRNA pellet obtained was dissolved in water (37.5 ul) and used for modification. To the above aminoacylated-tRNA solution, 2.5 ul of 1N NaHCO₃ was added (final conc. 50 mM, pH = 8.5) followed by 10 ul of 10 mM solution of BODIPY-FL-SSE (Molecular Probes) in water."

Looking at page 93 of the specification, one finds the following sentence at the bottom of the page and ending at the top of page 94:

"Ethanol (2.5 volumes) was added to the aqueous phase and the tRNA pellet obtained was dissolved in water (37.5 (l) and used for modification."

Thus, when viewing the specification as a whole, one skilled in the art would know that 37.5 ul are indicated for resuspension of the tRNA pellet - to which 2.5 ul and 10 ul are added for a final volume of 50 ul. Corrections of simple typographical errors should be left to the discretion of the Applicants or the Examiner may *sua sponte* submit a Certificate Of


Correction upon issue of the application. The Applicants complain that these corrections are not necessary.

Nonetheless, without acquiescing to the Examiner or waiving the above-indicated arguments, but to further the prosecution the specification has been amended to change "(l" to "μl" in the indicated paragraphs. Since the precise language is found on page 110 of the specification, there is no new matter.

CONCLUSION

The Applicants believe that the arguments and claim amendments set forth above traverse the Examiner's rejections and, therefore, request that all grounds for rejection be withdrawn for the reasons set above. Should the Examiner believe that a telephone interview would aid in the prosecution of this application, the Applicants encourage the Examiner to call the undersigned collect at 617.984.0616.

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